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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,111	02/11/1999	ICHIRO NAKANO	1046.1196/JD	8405
21171	7590	11/21/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			AN, SHAWN S	
			ART UNIT	PAPER NUMBER
			2613	

DATE MAILED: 11/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/248,111	Applicant(s) NAKANO ET AL.	
	Examiner Shawn S. An	Art Unit 2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 5-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on 11/02/05 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/248,111 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. As per Applicant's instructions as filed on 11/02/05, claims 1-4 have been amended and claim 23 has been newly added.

With respect to newly added claim 23, the Applicant previously elected the embodiment depicted in Fig. 1, on which claims 1-4 read, as a response to the restriction requirement as filed on 1/23/04, hence having withdrawn claims 5-22.

Upon further review, the newly added claim 23 reciting "... receiving control information input by a user with respect to ..., and compressing the received control information, ..." is not represented (described) with respect to Fig. 1. At best, the another embodiment Fig. 3, element 25 (instruction unit) seems to describe a concept substantially similar to the above claim 23 limitations.

Since Applicant did not elect the embodiment represented by Fig. 3 as the response to the restriction requirement as filed on 1/23/04, and claim 23 limitations as discussed above most resemble the element 25 of Fig. 3, the claim 23 is now considered a withdrawn claim.

Therefore, the newly added claim 23 has not been given a merit on the full patent evaluation/examination.

Response to Remarks

3. Applicant's arguments with respect to amended claims as above have been carefully considered but are moot in view of the new ground(s) of rejection incorporating the previously cited prior art reference (Ishikawa et al).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 and 3-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishikawa et al (5,818,970).

Regarding claims 1 and 3-4, Ishikawa et al discloses a moving image data controlling apparatus/method, and computer readable medium storing a program for executing operations (col. 32, lines 60-64), comprising:

a moving image source input unit (Fig. 1, 102) inputting moving image data;

a moving image data encoding unit (109) compressing the moving image data from the moving image source input unit;

an information input unit (Fig. 1, 103; Fig. 29, 2006) inputting control information externally produced and designating a processing for arbitrary designated partial image data (bit map information/data) of the moving image data inputted through the moving image source input unit (col. 5, lines 42-63; col. 20, lines 10-25).

a control information encoding unit (Fig. 1, 110 or 111; Fig. 29, 2007) compressing the control information from the information input unit;

a data integrating unit (112) integrating a compressed image data from the moving image data encoding unit with a compressed control information from the information encoding unit (col. 5, lines 42-63); and
storing the image data and the control information which are integrated (col. 3, lines 18-20).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishikawa et al (5,818,970).

Regarding claim 2, Ishikawa et al discloses a moving image data controlling apparatus, comprising:

a moving image source input unit (Fig. 1, 102) inputting moving image data comprising plural data of a predetermined partial image unit;

a moving image data encoding unit (109) compressing the moving image data from the moving image source input unit;

an area information input unit (Fig. 1, 103; Fig. 29, 2006) inputting area information externally produced and defined for each arbitrary designated predetermined partial image (bit map information/data) unit of the moving image data inputted through the moving image source input unit (col. 5, lines 42-63; col. 20, lines 10-25).

an area information encoding unit (Fig. 1, 110 or 111; Fig. 29, 2007) compressing the area information from the area information input unit; and

a data integrating unit (112) integrating a compressed area information from the area information encoding unit, as additional information for all pixels in each arbitrary designated predetermined image unit of the moving image data inputted through the moving image source input, with a compressed digital moving image data from the moving image data encoding unit (col. 5, lines 42-63).

Even though Ishikawa et al does not specifically disclose digital images, the Examiner takes official notice that it is well known in the art.

Therefore, it would have been obvious to a person of ordinary skill in the relevant art employing a moving image data controlling apparatus as taught by Ishikawa et al to substitute the moving image source with the digital moving image source in order to enhance the quality of the image data.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Shawn S An whose telephone number is 571-272-7324.
9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
10. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


SHAWN AN
PRIMARY EXAMINER

11/16/05